Atty. Docket No. CPAC 1029-7
Appl. No. 10/681,584

PATENT

Remarks

This Response supplies an omission or correction in the Applicant's reply to the prior Office action (response to provisional double patenting rejections).

Amendments to the Specification and to the Drawings, and the Remarks pertaining to the Drawings Objections, made in Applicant's reply to the prior Office action, are incorporated by reference herein and, it is believed that the Drawings Objections have been met thereby.

Also, Remarks directed to Rejections Under 35 U.S.C. § 102(b) and to Rejections Under 35 U.S.C. § 103(a) made in Applicant's reply to the prior Office action, are incorporated by reference herein and, it is believed that the Rejections Under 35 U.S.C. § 102(b) and the Rejections Under 35 U.S.C. § 103(a) have been addressed thereby.

Claims 1 - 22 are in the Application, of which claims 12 - 20 have been withdrawn as directed to a nonelected invention. Accordingly, claims 1 - 11, 21 and 22 are now under consideration in the application.

These Remarks contain a new response to the provisional Double Patenting rejections in the prior Office action.

Applicant thanks Examiner Chambliss for responding by telephone to inquiries by Applicant's representative, undersigned, regarding the procedure following a provisional double patenting rejection; and Applicant thanks Cassandra Spyrou, TC 2800, for responding by telephone to Applicant's representative, undersigned, on June 21, 2005, and for her helpful suggestions as to how to make a suitable reply to a provisional double patenting rejection.

Ms Spyrou suggested that the Applicant may proceed by any of three available options to this point in the prosecution, namely: file a Terminal Disclaimer; amend claims; or traverse the rejection.

As Applicant's representative pointed out, where no patent has yet issued and no claim has yet been allowed in a reference application, there would appear to be no predicate upon which Applicant can make a reasonable response. For example, Applicant cannot reasonably make a Terminal Disclaimer with respect to a reference application from which it is not yet known whether any patent will be granted. And, for example, when prosecution of the claims is not yet complete in a reference application, it is not possible to know whether the claims in the instant

application claim the same invention as (for a statutory type double patenting rejection), or are patentably distinct from, claims in any patent that may issue from the reference application and, accordingly, Applicant cannot yet know whether, or how, any claim amendment should be made in the instant application.

Ms Spyrou suggested, in such circumstances, that Applicant traverse the rejection on the grounds that it is not at this time possible to know what claims may eventually issue in the reference application and, accordingly, it is not possible to know whether the claims in the instant application will be patentably distinct, with or without amendment, from claims in any patent that may be granted on the reference application. Applicant responds accordingly, below.

Double Patenting

Claims 1 – 11, 21 and 22 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting: over claim 1 of copending Application No. 10/681,572; over claim 1 of copending Application No. 10/681,734; or over claim 1 of copending Application No. 10/681,584 (the "Reference Applications"). (All these applications were filed on the same date, and are commonly owned.)

To the extent a reply may be required at this point in prosecution, these rejections are traversed, on the grounds following.

As the prior Office action noted, these are provisional double patenting rejections because the claims that are alleged to be conflicting have not in fact been patented. Moreover, prosecution of the claims is not yet complete in any of the Reference Applications: Claim 1 in each of the Reference Applications stands rejected under 35 U.S.C. § 103 and/or § 102, and it is unknown to Applicant at this time whether (or to what extent) Applicants' responses to these rejections may be successful. Thus, it is not at this time possible to know what claims may eventually issue in any of the Reference Applications and, accordingly, it is not possible to know whether the claims in the instant application will be patentably distinct, with or without amendment, from claims in any patent that may be granted on any of the Reference Applications.

As the MPEP notes,

> Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications ..., the courts have sanctioned the practice of making

> applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

(MPEP 804.I.B.) Applicant appreciates the Examiner's attention in having made the Applicant aware of what appeared to the Examiner to be a potential double patenting problem in the instant application. In the instant application, however, for the reasons noted above, it is not possible for the Applicant to resolve the issue at this time. Applicant expects that the provisional double patenting rejections will be maintained as long as there are conflicting claims in more than one application, until prosecution has proceeded to the point that the double patenting rejection is the only rejection remaining in one of the applications.

> The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications.

(MPEP 804.I.B.) Then:

> If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

(MPEP 804.I.B.) This orderly process will allow the Applicant at an appropriate time to determine an appropriate response (traversal; or claim amendment; or terminal disclaimer) to any double patenting rejection (fully matured, not "provisional") that may have been maintained in an application following issuance of a patent in another application that is alleged to have conflicting claims.

Applicant again thanks Examiner Chambliss for his attention to this matter and Ms Spyrou for her assistance in determining what constitutes a sufficient reply at this juncture. It is believed that the foregoing constitutes a complete response to the provisional double patent rejections and, accordingly, reconsideration of the application, as amended in the reply to the prior Office action, is respectfully requested.

Atty. Docket No. CPAC 1029-7
Appl. No. 10/681,584

PATENT

This Response is being filed within the one month shortened statutory period set by the Examiner for response to the Office action and, accordingly, no fee is required. In the event the Examiner may determine that additional fee[s] may be required in connection with the filing of this paper, the Commissioner is authorized to charge any additional fee (or to credit any overpayment) to Deposit Account No. 50-0869 (CPAC 1029-7).

If the Examiner determines that a conference would facilitate prosecution of this application, the Examiner is invited to telephone Applicants' representative, undersigned, at the telephone number set out below.

Respectfully submitted,

/Bill Kennedy/ Reg No. 33,407

Bill Kennedy
Reg. No. 33,407

Haynes Beffel & Wolfeld LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340